

Application No. 10/660,063
Amendment and Response to the Office Action Dated February 23, 2007
Docket GB920020082U51

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REMARKS/ARGUMENTS

Claims 1-31 are pending in this application with claims 1, 15, and 29-31 being in independent form. Claims 1, 15, 29-31 have been amended.

Claim Objections

The Patent Office objected to claims 1 and 15 because of informalities. Claims 1 and 15 have been amended obviating the claim objections.

Claims Rejections - 35 U.S.C. § 112

The Patent Office rejected claims 15-25 and 27-29 under 35 U.S.C. § 112 ¶ 1 as based on a disclosure which is not enabling. (Present Office Action, Page 2). The Patent Office asserts that displaying the message is critical or essential to the practice of the invention. (Present Office Action, Page 2).

Applicant respectfully traverses. The present invention relates to modifying the text of a chat transcript. The text of the chat transcript is modified prior to being transmitted to interested viewers. Consequently, displaying the modified message is neither critical or essential to the practice of the invention.

Claim Rejections - 35 U.S.C. § 101

The Patent Office rejected claims 15-29 under 35 U.S.C. § 101. (Present Office Action, Page 2). The Patent Office stated that, "independent claims 15, 29 recite limitations for which the end results are neither tangible nor concrete." (Present Office Action, Pages 2-3).

Applicant respectfully traverses. In *State Street Bank* the Court of Appeals for the Federal Circuit held the "the transformation of data, representing discrete dollar amounts, by a machine through a series of

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mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"--a final share price momentarily fixed for recording and reporting purposes[.]" State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368, at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998). The Court held the result was useful, concrete and tangible because a final share price was momentarily fixed, not because the final share price was recorded or reported. A claimed invention produces a useful, concrete and tangible result if, as a whole, it accomplishes a practical application. MPEP § 2106(II)(A).

The present invention accomplishes a practical application by converting the text of a chat into a transcript that is more interesting to read and it is easier for readers to understand the context of the transcript. Because the claimed invention accomplishes a practical application, it therefore yields a useful, concrete and tangible result and the Patent Office's rejection should be withdrawn.

Claim Rejections 35 U.S.C. § 102

The Patent Office rejected claims 1, 2, 7, 8, 13, 15, 16, 21, 22, 27, 29-31 are rejected under 35 U.S.C. § 102 as anticipated by United States Patent Number 7,099,867 issued to Okada, et al. (hereinafter Okada).

Applicant respectfully traverses. "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540. Applicant submits claims 1, 15, and 29-31 recite elements which have not been disclosed, taught or suggested by Okada. For example claims 1, 15, and 29-31 generally recite alteration of a chat transcript in the form of addition of text, deletion of text, or replacement of text. Rather, Okada merely relates to determination of the degree of importance of a keyword for a received message in a chat system and

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indication of a received message containing a keyword. Consequently, elements of claims 1, 15, and 29-31 have not been disclosed by Okada. Claims 1, 15, and 29-31 should be allowed. Further claims 2, 7, 8, and 13 which depend from claim 1, and claims 16, 21, 22 and 27 which depend from claim 15, are also believed to be allowable.

35 U.S.C. § 103

The Patent Office rejected claims 3-6, 9-12, 14, 17-20, 23-26, and 28 under 35 U.S.C. § 103. (Present Office Action, Pages 5-9).

Applicant respectfully traverses. If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. (emphasis added) In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant submits that because the Patent Office did not reject independent claims 1 or 15 as obvious, therefore the Patent Office has recognized claims 1 and 15 as non-obvious. (Present Office Action, Pages 5-9). As the Patent Office is aware if an independent claims is non-obvious under 35 U.S.C. § 103 then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, claims 3-6, 9-12, and 14 depending from claim 1, and claims 17-20, 23-26, and 28, depending from claim 15 should be allowed.

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CONCLUSION

In light of the forgoing amendments and arguments, reconsideration of the claims is hereby requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted, on behalf of,
IBM Corporation

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